

## REMARKS

Claims 1-50 and 52-63 are presently pending in the case. Claims 1, 8, 13, 15, 16, 21-23, 27, 30, 31, 33, 35, 37, 46, 52, 54, 55, 57, 59, and 61 have been amended. Claim 51 has been cancelled without prejudice or disclaimer. The new claims are supported by the specification and claims as originally filed.

Reconsideration of the present case in view of the above amendments and the remarks herein is requested.

### **Allowable Claims**

Applicant acknowledges with appreciation the Examiner's indication that dependent claims 19, 20, 22, 30-36, 40-42, 50, 54-60, and 63 contain allowable subject matter. Though Applicant does not agree with the Examiner's rejections, claims 54, 55, 57, and 59 have been re-written in independent form in order to expedite prosecution. Applicant reserves the right to pursue the rejected claims in continuing applications. Accordingly, independent claims 54, 55, 57, and 59 are allowable. Claims 19, 20, 22, 30-36, 40-42, 50, and 63 have not been placed in independent form since they depend from an allowable claim, as discussed below.

### **Claim rejections under 35 USC 102**

The Examiner rejected claims 1, 3, 5-7, 11, 15, 16, 18, 21, 25-29, 38, 39, 45, 51-53, and 61 under 35 USC 102(b) as being anticipated by PCT publication WO 99/44663 to McGinn et al (hereinafter McGinn et al). The rejection is traversed.

The Examiner has not shown that McGinn et al qualifies as prior art under 35 USC 102(b). The publication date of McGinn et al is September 10, 1999. The present application claims priority to December 17, 1999, which is less than one year after the publication of McGinn et al. Therefore, it is requested that the rejection under 35 USC 102(b) be withdrawn.

In addition, McGinn et al does not anticipate claims 1, 3, 5-7, 11, 15, 16, 18, 21, 25-29, 38, 39, 45, 51-53, and 61. Claim 1, for example, is to a method for conditioning a

packaged powder comprising, inter alia, providing a receptacle having an enclosed chamber containing an amount of a powder, providing at least one pulse of energy to the receptacle, and flowing a gas through the chamber to aerosolize the powder. McGinn et al discloses the application of a pulse of energy, but for the purpose of aerosolization. McGinn et al does not disclose providing a pulse of energy *and* flowing a gas through the chamber to aerosolize the powder. It is respectfully submitted that this positively recited combination of features is absent in the disclosure of McGinn et al, thereby precluding a section 102 rejection because each and every element of the claim is not disclosed within the cited reference. Thus, the Examiner is respectfully requested to reconsider the language of claim 1 and withdraw the rejection and the claim and the claims depending therefrom.

McGinn et al does not anticipate claim 15, either. Claim 15 is to a powder conditioning system comprising, inter alia, a receptacle, a mechanism to provide at least one pulse of energy to the receptacle, and an aerosolization mechanism to aerosolize powder in the receptacle by flowing gas through the chamber. McGinn et al does not disclose both a mechanism to provide a pulse of energy *and* an aerosolization mechanism. Therefore, McGinn et al does not anticipate claim 15 and its depending claims.

Additionally, McGinn et al does not anticipate claim 61. Claim 61 is to a method for aerosolizing a powder comprising, inter alia, placing a receptacle into an aerosolization device having an aerosolization system for extracting the powder from the receptacle by flowing gas through a chamber, and a mechanism to provide at least one pulse of energy to the receptacle. McGinn et al does not disclose an aerosolization system for extracting a powder by flowing gas through a chamber and a mechanism to provide a pulse of energy to a receptacle. Accordingly, McGinn et al does not anticipate claim 61 or its depending claims.

The Examiner rejected claims 1, 8, 9, 11, 15, 23, 24, 26, 27, 37, 43-45, and 61 under 35 USC 102(b) as being anticipated by U.S. Patent 65,694,920 to Abrams (hereinafter Abrams). The rejection is traversed.

Abrams does not anticipate claims 1, 8, 9, 11, 15, 23, 24, 26, 27, 37, 43-45, and 61. Claim 1, for example, is to a method for conditioning a packaged powder comprising, inter alia, providing a receptacle having an enclosed chamber containing an amount of a powder, providing at least one pulse of energy to the receptacle, and flowing a gas through the chamber to aerosolize the powder. Abrams discloses vibrating a powder for deaggregation of the powder.

However, Abrams does not disclose providing a pulse of energy *and* flowing a gas through the chamber to aerosolize the powder. Instead, Abrams aerosolizes the powder using electrostatic charge. Since Abrams does not disclose each and every feature recited in the claim, it does not anticipate claim 1. Applicant requests withdrawal of the rejection of claim 1 and its dependent claims.

Abrams also does not anticipate claim 15. Claim 15 is to a powder conditioning system comprising, inter alia, a receptacle, a mechanism to provide at least one pulse of energy to the receptacle, and an aerosolization mechanism to aerosolize powder in the receptacle by flowing gas through the chamber. Abrams does not disclose an aerosolization mechanism that aerosolizes by flowing gas through the chamber. Therefore, Abrams does not anticipate claim 15 and its depending claims.

Additionally, Abrams does not anticipate claim 37. Claim 37 is to a powder dispersion device comprising, inter alia, an aerosolization system in the housing to extract the powder from the receptacle and to entrain the powder in a gas stream to form an aerosol by flowing gas through a chamber. As discussed above, Abrams discloses an electrostatic aerosolization mechanism and does not disclose an aerosolization system in the housing to extract the powder from the receptacle and to entrain the powder in a gas stream to form an aerosol by flowing gas through a chamber. Therefore, Abrams does not anticipate claim 37 and its depending claims.

#### **Claim rejections under 35 USC 103(a)**

The Examiner rejected claims 2, 4, 12, 17, 46-49, 62 under 35 USC 103(a) as being unpatentable over McGinn et al, singly or in view of U.S. Patent 6,167,880 to Gorda et al (hereinafter Gorda et al) or Abrams. The rejection is traversed. The proposed modifications do not make up for the deficiencies of McGinn et al discussed above. Accordingly, the rejected claims are not rendered unpatentable by McGinn et al and Gorda et al and Abrams.

The Examiner also rejected claims 10, 13 and 14 under 35 USC 103(a) as being unpatentable over Abrams. The rejection is traversed. The proposed modifications do not make up for the deficiencies of Abrams discussed above. Accordingly, the rejected claims are not rendered unpatentable by Abrams.

**Claim Amendments**

Claims 1, 8, 13, 15, 16, 21-23, 27, 30, 31, 33, 35, 37, 46, 52, 54, 55, 57, 59, and 61 have been amended. The independent claims were amended to expedite prosecution, and Applicant reserves the right to pursue the originally submitted claims in continuing prosecution of the present case. The balance of the amendments were made to write dependent claims into independent form, to correct minor errors, or to remove unnecessary limitations and have not been made for reasons related to patentability.

**C nclusion**

The claims are allowable for the reasons given above. Thus, the Examiner is respectfully requested to reconsider the present rejections and allow the presently pending claims. Should the Examiner have any questions, the Examiner is requested to call the undersigned at the number given below.

Respectfully submitted,

NEKTAR THERAPEUTICS  
(formerly INHALE THERAPEUTIC  
SYSTEMS)

Dated: September 15, 2003

By: 

Guy V. Tucker  
Reg. No. 45,302

Please send all correspondence to:  
Guy Tucker  
Nektar Therapeutics  
(formerly Inhale Therapeutic Systems, Inc.)  
150 Industrial Road  
San Carlos, CA 94070  
Phone: (650) 620-5501  
Fax: (650) 631-3125